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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,832	07/28/2003	Giovanni Gambini	163-503	5833

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NEW YORK, NY 10036

EXAMINER

RODRIGUEZ, JOSEPH C

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/628,832	Applicant(s) GAMBINI, GIOVANNI	
	Examiner Joseph C Rodriguez	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/12/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

The disclosure is objected to as lacking appropriate section headings as outlined in 37 CFR 1.77. See also 37 CFR 1.72-1.77; MPEP § 608.01(a). Correction is required.

The abstract of the disclosure is objected to for improper content. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits (e.g., the improved device) or speculative applications of the invention and should not compare the invention with the prior art.

Claim Objections

The claims are objected to as the form of claims 1-7 is improper. Where a claim sets forth a plurality of elements or steps, as in the instant claims, each element or step should be separated by a line indentation. See MPEP 608.01(m) and 37 CFR 1.75(i).

Further, regarding claim 3, the language "can be" (ln. 2) may render the claims indefinite as it is unclear whether the features subsequent to the "can be" language are a necessary part of the claimed invention. Applicant must positively recite the features

of the claimed invention. Examiner thus recommends eliminating all instances of "can be" from the claim language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gambini (US 6,371,304) in view of Biagiotti (US 5,474,917) and Betti et al. ("Betti")(US 2003/0015077).

Gambini (Fig. 2, 5, with mobile wall 36) teaches all that is claimed except for expressly teaching thrusters and gripper elements including bands with suction holes, wherein said gripper elements are only activated when said mobile wall is absent. Biagiotti, however, teaches that the modifications of a suction box and thrusters are known in the trim processing arts (Fig. 1-10, suction box 30, thrusters 5; Abstract, col. 3, ln. 33-col. 5, ln. 43). Moreover, Biagiotti teaches that these features are improvements to the prior art roll processors, such as Gambini's, that merely relied on a gap in the feeding conveyors and gravity for separation (col. 1, ln. 8-58). Further, Betti teaches a similar roll sorter that selectively activates the suction box to separate rolls (Fig. 1, 4-8; para. 39-42). Here, it is implicit from the selective activation taught by Betti that a person having ordinary skill in the art would know to selectively activate the gripper

elements in coordination with the mobile wall for the benefit of ensuring the separation of unwanted trim. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Gambini as taught above for improved roll handling and separating.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weis et al. ("Weis") (US 4,462,287) in view of Biagiotti (US 5,474,917) and Betti et al. ("Betti")(US 2003/0015077).

Weis (Fig. 1-4, with mobile wall regarded as section 48 shown in fig. 3; col. 2, ln. 53-col. 3, ln. 22 describing actuating piston 76) teaches all that is claimed except for expressly teaching gripper elements including bands with suction holes, wherein said gripper elements are only activated when said mobile wall is absent. Biagiotti, however, teaches that the modifications of a suction box and thrusters are known in the trim processing arts (Fig. 1-10, suction box 30, thrusters 5; Abstract, col. 3, ln. 33-col. 5, ln. 43). Moreover, Biagiotti teaches that these features are improvements to the prior art roll processors, such as Gambini's, that merely relied on a gap in the feeding conveyors and gravity for separation (col. 1, ln. 8-58). Further, Betti teaches a similar roll sorter that selectively activates the suction box to separate rolls (Fig. 1, 4-8; para. 39-42). Here, it is implicit from the selective activation taught by Betti that a person having ordinary skill in the art would know to selectively activate the gripper elements in coordination with the mobile wall for the benefit of ensuring the separation of unwanted trim. Therefore, it would have been obvious at the time the invention was made to a

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person having ordinary skill in the art to modify the invention of Weis as taught above for improved roll handling and separating.

Conclusion

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Joseph C Rodriguez** whose telephone number is **571-272-6942** (M-F, 9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326** (After-Final **703-972-9327**).

The examiner's **UNOFFICIAL Personal fax number** is **571-273-6942**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

<http://pair-direct.uspto.gov>

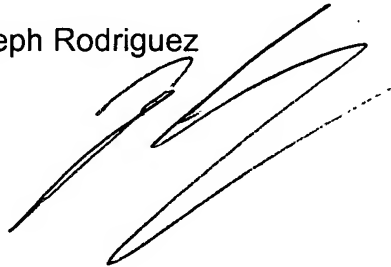
Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at **866-217-9197** (Toll Free).

Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **571-272-6584**. Further, the supervisor's contact information is Donald Walsh, 571-272-6944.

Signed by Examiner Joseph Rodriguez

jcr

May 25, 2005

A handwritten signature in black ink, appearing to be 'JR' with a large, sweeping flourish extending from the bottom right.